

REMARKS

Claims 1-9 are pending and stand ready for further action on the merits. Claims 7-9 have been withdrawn from consideration as being drawn to non-elected subject matter.

Election/Restriction

The Examiner has restricted the claims into the following groups:

- I. Claims 1-6, drawn to a fuel cell separator, classified in class 429, subclass 34.
- II. Claim 7, drawn to a method of manufacturing a fuel cell separator, classified in class 264, subclass 104.
- III. Claims 8-9, drawn to a solid polymer fuel cell, classified in class 429, subclass 30.

Applicants affirm the election of Group I, consisting of claims 1-6 with traverse.

Applicants traverse the restriction requirement as between Groups I and II for the following reasons. According to MPEP §803, if the search and examination of an entire application can be made without a serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. As evidence of the undue burden, the Examiner lists a single class/subclass for each of Groups I and II. As such, Applicants submit that including the search for the invention of

Group II does not amount to an undue burden placed upon the Examiner to examine all of claims 1-7. Applicants respectfully request that the Examiner rejoins Group II with Group I.

However, should the Examiner maintain the restriction requirement as between Groups I and II, Applicants respectfully remind the Examiner that should the product claims be found allowable, the process claims which depend from or otherwise include all the limitations of the allowable product claims are to be rejoined, see MPEP § 821.04.

Applicants traverse the restriction requirement as between Groups I and III for the following reasons. The Examiner has restricted between the fuel cell (Group III) claims and the fuel cell separator (Group I) claims using the reasoning set forth in MPEP 806.05(c)(I) for "SUBCOMBINATION NOT ESSENTIAL TO COMBINATION."

Applicants respectfully submit that the Examiner has **incorrectly** categorized the claims and respectfully submit that the correct reasoning is set forth in MPEP 806.05(c)(II) for "SUBCOMBINATION ESSENTIAL TO COMBINATION." This section describes the relationship as follows:

AB_{sp}/B_{sp} No Restriction

If there is no evidence that combination AB_{sp} is patentable without the details of B_{sp}, restriction should

not be required. Where the relationship between the claims is such that the separately claimed subcombination B_{sp} constitutes the essential distinguishing feature of the combination AB_{sp} as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

Under this analysis, the fuel cell separator composition described in claims 1-6 is the subcombination " B_{sp} " and the solid polymer fuel cell in claims 8-9 is the combination " AB_{sp} ". Here, the relationship between the claims is such that the separately claimed subcombination " B_{sp} ", the fuel cell separator composition, constitutes the essential distinguishing feature of the combination " AB_{sp} " (the solid polymer fuel cell). Thus, the inventions are not distinct and a requirement for restriction as between claims 1-6 and claims 8-9 must not be made. As such, rejoinder of Group III with Group I is respectfully requested.

Drawings

The Examiner objects to Figure 1 for not indicating that the drawing is of the prior art. In response, Applicants enclose herewith a replacement sheet of Figure 1 which indicates that the drawing is of a prior art apparatus.

As such, Applicants respectfully request that the objection to the Figures be withdrawn.

Issues under 35 U.S.C. 103

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. US 6,242,142 in view of Japanese Publication JP 11-256009 (hereinafter JP '009). Applicants respectfully traverse the rejection.

Based on this rejection the following issues need to be addressed:

- (A) the rejection under 35 U.S.C. §103 based on 35 U.S.C. §102(e); and
- (B) since Saito et al. claims priority to Japanese Patent Application 7-194333 (JP '333) filed July 5, 1995. Since JP '333 is the priority document for WO97/02612 (WO '612) which published January 23, 1997, WO '612 would theoretically be available under 35 U.S.C. §103 based on

35 U.S.C. §102(b). A copy of WO '612 is enclosed for the Examiner's convenience.

Issue (A)

With regard to the rejection under 35 U.S.C. §103 based on 35 U.S.C. §102(e), according to MPEP § 706.02(1)(1), effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made" owned by the same person or subject to an obligation of assignment to the same person."

MPEP § 706.02(1)(2) instructs that an attorney or agent of record may make a statement to the effect that that application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Statement Evidencing Common Ownership

The present application, and the U.S. Patent to Saito et al. were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Consequences Of The Above-Statement

Accordingly, Applicant respectfully submits that the reference, Saito et al., is not available as prior art under 35 U.S.C. § 102(e)/§ 103(c).

Issue (B)

Applicants respectfully submit that the present invention is not made obvious under 35 U.S.C. §103 by the theoretical combination of WO '612 and JP '009.

First, Applicants respectfully submit that the skilled artisan would not be motivated to look to the teachings of JP '009 to modify the fuel cell separator of WO '612. The mere fact it is possible for isolated disclosures to be combined does not render the result of that combination obvious absent a logical reason of record which justifies the combination. *In re Regel et al.* (CCPA 1975) 526 F2d 1399, 188 USPQ 136. To properly combine references to reach a conclusion of obviousness, there must be some teaching, suggestion of inference in either or both of the references, or knowledge generally available to one of ordinary skill in the art, *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Interfer. 1993), which would have led one to combine the relevant teachings of the two references. *Ashland Oil Inc. v. Delta Resins and Refractories, Inc. et al.* (CAFC 1985) 776 F2d 281, 227 USPQ 657.

Both the suggestion to make the claimed composition or device or carry out the claimed process and the reasonable expectation of success must be founded in the prior art, not in Applicant's disclosure. *In re Vaeck* (CAFC 1991) 947 F2d 488, 20 PQ2d 1438. The combination is improper if one of the references is non-analogous art. *In re Clay* (CAFC 1992), 23 PQ2d 1058.

Applicants are aware that WO '612 states that the "thermosetting resin used ... is not particularly limited." (See column 4, lines 52-53 of Saito et al. US 6,242,142). However, this refers to the thermosetting resin itself, *per se*, and there is no mention that additives having similar properties to the inventive polyvalent oxazine compound with a plurality of oxazine rings can be added.

Moreover, JP '009 fails to suggest that the thermosetting resin composition is suitable for use as a binder of a fuel cell separator. Accordingly, there is no incentive for skilled artisan to combine two cited references, and the instant invention is patentable over the theoretical combination of WO '612 and JP '009.

Conclusion

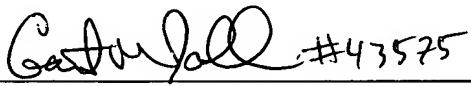
In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, Ph.D., Esq., (Reg. No. 43,575) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment(s): (1) Replacement Sheet of Fig. 1
(2) Verified Translation of the Priority Document
(3) WO '612 and English Abstract